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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/087,204	03/01/2002	Avery Li-Chun Wang	Landmark Digital Serv.-P0	8574
29053	7590	12/20/2005	EXAMINER	
DALLAS OFFICE OF FULBRIGHT & JAWORSKI L.L.P. 2200 ROSS AVENUE SUITE 2800 DALLAS, TX 75201-2784			LEROUX, ETIENNE PIERRE	
			ART UNIT	PAPER NUMBER
			2161	

DATE MAILED: 12/20/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>
	10/087,204	WANG ET AL.
	<b>Examiner</b>	<b>Art Unit</b>
	Etienne P LeRoux	2161

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on 06 October 2005.
- 2a) This action is FINAL.                    2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 1-18 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_\_ is/are allowed.
- 6) Claim(s) 1-18 is/are rejected.
- 7) Claim(s) \_\_\_\_\_ is/are objected to.
- 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on 01 March 2002 is/are: a) accepted or b) objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) All    b) Some \* c) None of:  
 1. Certified copies of the priority documents have been received.  
 2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | Paper No(s)/Mail Date. _____  |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>10/2005</u> . | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
|  | 6) <input type="checkbox"/> Other: _____                                    |

*Continued Examination*

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 10/6/2005 has been entered.

*Claim Status:*

Claims 1-18 are pending. Claims 1-18 are rejected as detailed below.

*Claim Objections*

Claim 1 is objected to because of the following informalities: Claim 1 includes "transmitting the plurality of parameters to a predetermined served." Appropriate correction is required, i.e., examiner suggests predetermined server.

*Claim Rejections - 35 USC § 112*

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 1-18 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in

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the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

Claims 1 and 10 recite “processing the plurality of parameters into a plurality of fingerprints/landmarks used in a recognition process.” The specification does not contain a clear and concise description of the process of making the claimed fingerprints/landmarks such that a skilled artisan can make and use the present invention without undue experimentation. In particular, the specification does not identify any of the “plurality of parameters” nor does the specification disclose how many parameters are processed nor does the specification disclose the process whereby the plurality of parameters are converted into a fingerprint/landmark.

Claims 8 and 17 recite “wherein the media includes a file stored on a memory device of the user’s personal computer.” The skilled artisan would not know how to make and user the invention because the specification does not provide a clear and concise description of the manner and process of making a media file which is stored in the memory of a user’s personal computer. The specification of the present application discloses extracting raw parameter data from a CD in the drive of a user’s CD player and the extraction of raw parameter data from streaming audio. Furthermore, the specification in paragraph 6 states that no copy of the original file is created not even on a temporary basis. One of ordinary skill in the art would not know how to use the present invention such that raw parameter data is extracted from a user’s hard drive.

Claims 9 and 18 are similarly rejected for including language of like nature to claims 8 and 17.

Claims 2-7 and 11-16 are rejected for being dependent from a rejected base claim.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-18 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 1 provides for the use of a recognition process, but, since the claim does not set forth any steps involved in the method/process, it is unclear what method/process applicant is intending to encompass. A claim is indefinite where it merely recites a use without any active, positive steps delimiting how this use is actually practiced.

Claim 2 includes similar language to claim 1 and is rejected on the same basis.

Claims 10 and 11 include language similar to claims 1 and 2 and are thus rejected for the same reason.

Claims 3-9 and 12-18 are rejected for being dependent from a rejected base claim.

#### *Art Rejection Precluded*

Claims 8, 9, 17 and 18 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. Applicant's arguments regarding lack of enablement provided in applicant's response of ~~12/29/2004~~<sup>10/6/2005</sup> were carefully considered but were not persuasive. The above rejection is thus maintained under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. No art rejection of claims 8, 9, 17 and 18 is provided in this final office action.

***Claim Rejection - 35 U.S.C. 101***

Claims 1-18 are rejected under 35 U.S.C. 101 because the claimed recitation of a use, without setting forth any steps involved in the process, results in an improper definition of a process, i.e., results in a claim which is not a proper process claim under 35 U.S.C. 101. See for example *Ex parte Dunki*, 153 USPQ 678 (Bd.App. 1967) and *Clinical Products, Ltd. v. Brenner*, 255 F. Supp. 131, 149 USPQ 475 (D.D.C. 1966). Claim 1 includes “fingerprints/landmarks used in a recognition process.” The method of recognizing the known media sample from “processed” parameters, i.e., fingerprints/landmarks, is not described in the specification. The present invention thus is not concrete, tangible and useful because processing parameters which are characterized as fingerprints/landmarks is not a practical application in the endeavor of audio recognition.

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1-4, 6, 7, 10-13 and 15-17 are rejected under 35 U.S.C. 102(e) as being anticipated by US Pat No 6,505,160 issued to Levy et al (hereafter Levy), as best examiner is able to ascertain.

Claims 1 and 10:

Levy discloses:

- extracting a plurality of parameters from a media including a known media sample during a playing of the media by a user [col 9, lines 40-60]
- transmitting the plurality of parameters to a predetermined server [col 4, line 42] on a communication network, which predetermined server is coupled to a recognition database [col 4, lines 1-13]
- storing the plurality of parameters in the recognition database along with an identity of the known media sample [col 4, lines 1-13];
- processing the plurality of parameters into a plurality of fingerprints/landmarks [col 9, lines 40-60]

Claims 2 and 11:

Levy discloses sending, simultaneously with transmitting the plurality of parameters to the server, metadata [col 9, lines 40-60] used to identify the media sample to a second predetermined server; and forwarding a resulting identification to the server coupled to the recognition database [abstract]

Claims 3 and 12:

Levy discloses returning the resulting identification to the user and then uploading the resulting identification with transmitting of the plurality of parameters [col 6, lines 29-43]

Claims 4 and 13:

Levy discloses wherein the resulting identification is forwarded directly to the first predetermined server coupled to the recognition database [col 4, lines 1-13]

Caims 6 and 15:

Levy discloses wherein the media includes a compact disk or digital video disk that is played on the user's personal computer [Fig 1, col 3, lines 50-55]

Claims 7 and 16:

Levy discloses the media includes a streaming media sample being played on the user's personal computer [abstract].

*Claim Rejections - 35 USC § 103*

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 5 and 14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Levy in view of US Pat No 6,292,185 issued to Ko et al (hereafter Ko), as best examiner is able to ascertain.

Claims 5 and 14:

Levy discloses the essential elements of claims 1/10 as noted above but does not disclose performing a check prior to extracting the plurality of parameters to determine whether the

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recognition database currently holds a latest version of the media sample before extracting the plurality of parameters. Ko discloses a user's computer checking if the version of a configuration file is the latest [Fig 5, col 5, lines 45-50]. It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Levy to include performing a check prior to extracting the plurality of parameters to determine whether the recognition database currently holds a latest version of the media sample before extracting the plurality of parameters based on the teachings of Ko for the purpose of ensuring that the data files in the user's computer are the same version as the data files in the web site [abstract].

### *Response to Arguments*

Applicant's arguments filed 10/6/2005 have been fully considered but they are not persuasive.

#### **Applicant Argues:**

Applicant maintains that claims 8, 9, 17 and 18 comply with the enablement requirement under 35 U.S.C. 112, first paragraph. Applicant states "The applicant respectfully points out that the claimed invention is drawn to 'extracting a plurality of parameters from a media' not scanning a user's hard drive. The media from which a plurality of parameters may be extracted includes a CD or computer hard-drive. (paragraph 0027). The applicant further points out that a software process extracts the parameters from the media (see abstract paragraph 22). Therefore, it is not necessary for one to 'make a media file stored on a computer' as the examiner claims (Final Action, pg. 2). Put simply, the disclosed software process executes the extraction process. As such, one of ordinary skill in the art could practice the claimed invention."

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**Examiner Responds:**

Examiner is not persuaded. Examiner maintains applicant has addressed the limitations of claim 1 (perhaps) but certainly not the limitation(s) of claims 8 and 17 which recite “wherein the media includes a file stored on a memory device of the user’s personal computer.” The specification does not include a clear and concise written description of the claimed media which includes a file which is stored on a user’s computer such that one of ordinary skill in the art can make and use the present invention without undue experimentation. Claim 1 includes a known media sample which is played by the user. Claim 8 further qualifies the media sample by claiming that the media sample is stored in the memory on a user’s computer. Examiner maintains that such an action may infringe copyright protection. In any event, the specification does not include any reference to storing a media sample in a memory device of the user’s computer and thus the present invention is not enabled such that one of ordinary skill in the art can make and use the invention without undue experimentation.

**Applicant Argues:**

Applicant maintains that US Pat No 6,061,680 does not anticipate the present invention.

**Examiner Responds:**

Examiner is not persuaded. The present invention, as claimed lacks enablement and is indefinite and thus it is difficult to determine exactly what applicant has invented. Nevertheless, above new art rejection has been provided which, as best examiner is able to ascertain, more accurately reads on the present invention.

***Conclusion***

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure: US Pat No 6,549, 922 issued to Srivastava et al discloses automatic extraction and transformation of metadata into logical annotations (fingerprints/landmarks) which are associated with the media sample.

***Contact Information***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Etienne P. LeRoux whose telephone number is (571) 272-4022. The examiner can normally be reached Monday through Friday between 8:00 am and 4:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Safet Metjahić can be reached on (571) 272-4023. The fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Etienne LeRoux

12/16/2005